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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,505	12/01/2004	Frank Bennett	PTS-0055USA	8621

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EXAMINER	
GIBBS, TERRA C	

ART UNIT	PAPER NUMBER
1635	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/516,505	BENNETT ET AL.	
	Examiner	Art Unit	
	Terra C. Gibbs	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,16-18,20,22,24,25,27-30,33-35,38,40-49 and 66-80* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-3, 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40-49, and 66-80* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's Preliminary Amendment filed December 1, 2004.

Claims 4-15, 19, 21, 23, 26, 31, 32, 36, 37, 39, and 50-65 have been canceled. New claims 66-80 are acknowledged.

Claims 1-3, 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40-49, and 66-80 are pending in the instant application.

Claims 1-3, 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40-49, and 66-80 are subject to restriction as detailed below:

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 2, 3, 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, and 68, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 197 to 216 of SEQ ID NO:4, and wherein said

compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group II. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, and 67-69, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 369-388 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group III. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 70, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 380-399 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group IV. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 71, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within

nucleotides 394-413 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group V. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 72, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 410-429 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group VI. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 73, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 419-438 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group VII. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 74, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4),

wherein said compound specifically hybridizes within nucleotides 427-446 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group VIII. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 76, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 769-788 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group IX. Claims 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 77, drawn to a compound targeted to a nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 798-817 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Group X. Claim 16-18, 20, 22, 24, 25, 27-30, 33-35, 38, 40, 41, 43, 44, 46, 67, 68, and 78, drawn to a compound targeted to a

nucleic acid molecule encoding ERK-6 (SEQ ID NO:4), wherein said compound specifically hybridizes within nucleotides 807-826 of SEQ ID NO:4, and wherein said compound inhibits the expression of ERK-6, and methods of administering said nucleic acid to cells and tissues such that ERK expression is inhibited.

Claims 1, 42, 45, 49, 66, 75, 79, and 80 links inventions of Groups I-X. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims, claims 1, 42, 45, 49, 66, 75, 79, and 80. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

This application does not comply with the requirements of unity of invention (Rules 13.1, 13.2, and 13.3) for the following reasons:

The inventions listed as Groups I-X do not relate to a single general

inventive concept under PCT Rule 13.1 because, PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

According to the guidelines in Section (f)(i)(a) of Annex B of the PCT Administrative Instructions, the special technical feature as defined by PCT Rule 13.2 shall be considered to be met when all the alternatives of a Markush-group are of similar nature. For chemical alternatives, such as the claimed compounds targeted to a nucleic acid molecule encoding ERK-6 and methods of using said compound, the Markush group shall be regarded as being of similar nature when:

(A) all alternatives have a common property or activity and

(B)(1) a common structure is present, i.e., a significant structure is shared by all of the alternatives or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to an art-recognized class of compounds in the art to which the invention pertains.

The compounds targeted to a nucleic acid molecule encoding ERK-6 and methods of using said compound listed in Groups I-X do not meet the criteria of (B)(1), where a common structure is present, i.e., a significant structure is shared by all of the alternatives. The special technical feature compounds targeted to a nucleic acid molecule encoding ERK-6 and methods of using said compound listed in Groups I-X do not meet the criteria of (B)(1), as they do not share, one with another, a common core structure. Accordingly, unity of invention between the compounds targeted to a nucleic acid molecule encoding ERK-6 and methods of using said compounds listed in Groups I-X is lacking and each

special technical feature compound targeted to a nucleic acid molecule encoding ERK-6 and methods of using said compound claimed is considered to constitute a special technical feature.

Thus, in summary, each of Groups I-X is directed to different special technical features, namely distinct and independent nucleotide sequences, and thus supports this lack of unity.

The inventions listed as Groups I-X and Group XI do not relate to a single general inventive concept under PCT Rule 13.1 because, PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: the special technical feature method of inhibiting blood vessel formation in mammalian tissue by reducing expression of integrin β mRNA in cells listed in Group XI does not meet the criteria of (B)(1), as they do not share, one with another, a common core structure with the special technical feature methods of inhibiting ERK-6 expression in cells as listed in Groups I-X. Accordingly, unity of invention between the methods of Groups I-X and Group X is lacking since each respective method recited is considered to constitute a special technical feature.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terra C. Gibbs whose telephone number is 571-272-0758. The examiner can normally be reached on 9 am - 5 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tcg
August 28, 2006